THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT S. RING

Appeal No. 96-3968
Application No. 08/117,669[1]

ON BRIEF

Before LYDDANE, STAAB, and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 26, which are all of the claims pending in this application.

We AFFIRM-IN-PART and enter a new ground of rejection pursuant to 37 CFR § 1.196(b).

---

[1] Application for patent filed September 8, 1993.

BACKGROUND

The appellant's invention relates to a form burster. Claims 1 and 15 are representative of the subject matter on appeal and a copy of those claims, as they appear in the appellant's brief, is attached to this decision.

The prior art references of record relied upon by the examiner as evidence of anticipation under 35 U.S.C. § 102 (b) and obviousness under 35 U.S.C. § 103 are:

Hageman	2,513,093	June 27, 1950
Jones et al. (Jones)	3,942,694	March 9, 1976
Gergely, Jr. et al. (Gergely)	5,060,838	Oct. 29, 1991
Nakamura et al. (Nakamura)	5,104,022	Apr. 14, 1992

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Nakamura.

Claims 2, 4, 5, 7, 8 and 15 through 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Nakamura.

Claims 6 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Nakamura in view of Jones.

Claims 3, 10, 11, 13, 14 and 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Nakamura in view of Hageman.

Claim 12 stands rejected under 35 U.S.C. § 103 as being unpatentable over Nakamura in view of Hageman and Jones.[2]

Claims 1, 2, 9 and 22 through 26 stand rejected under 35 U.S.C. § 103 as being unpatentable over Gergely in view of Hageman.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the §§ 102 (b) and 103 rejections, we make reference to the examiner's answer for the examiner's complete reasoning in support of the rejections, and to the appellant's brief (Paper No. 13, filed April 6, 1995) for the appellant's arguments thereagainst.

---

[2] We note that the final rejection (Paper No. 7, mailed August 22, 1994) set forth this ground of rejection against claim 12. However, the examiner's answer (Paper No. 14, mailed June 26, 1995) did not contain this ground of rejection. Nevertheless, since the examiner's answer did not withdraw this ground of rejection, we consider this rejection of claim 12 before us in this appeal.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, to the October 4, 1994 declaration of Robert S. Ring and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

We will not sustain the examiner's rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated by Nakamura. We agree with the appellant's argument (brief, p. 6) that the gap between Nakamura's feed-in rollers 26a and 26b does not satisfy the "fixed gap" limitation of claim 1. We disagree with the examiner's determination (answer, p. 4) that Nakamura discloses a fixed gap between Nakamura's feed-in rollers 26a and 26b. Nakamura specifically teaches that the gap between the feed-in rollers 26a and 26b is adjusted by a gap adjusting means.[3] As discussed in column 10, line 3, to column 11, line 20 and as shown in Figures 8 and 9 of Nakamura, the gap between the feed-in rollers 26a and 26b changes as each continuous paper sheet is

[3] See column 7, line 30, to column 8, line 2, of Nakamura.

fed. For example, when a thick continuous paper sheet is fed, the feed-in rollers 26a and 26b and incremented in eight pulses to close the gap therebetween followed by eight pulses to widen the gap. Thus, the feed-in rollers 26a and 26b are not mounted to have a "fixed gap" therebetween. Since all the limitations of claim 1 are not met by Nakamura, we will not sustain the examiner's rejection thereof under 35 U.S.C. § 102(b).

We will not sustain the examiner's rejection of claims 2 through 8, 10 through 14, 18 and 19 under 35 U.S.C. § 103 as being unpatentable over Nakamura, alone or in combination with Jones and/or Hageman. Similar to claim 1, these claims all require the guide elements/slow speed rolls to have a "fixed gap" therebetween. In rejecting these claims under 35 U.S.C. § 103, the examiner relied upon Nakamura as teaching this "fixed gap" limitation. However, as discussed above, we do not agree with the examiner on this matter. Since the "fixed gap" limitation is not taught or suggested by the prior art applied by the examiner, we will not sustain the examiner's rejection of claims 2 through 8, 10 through 14, 18 and 19 under 35 U.S.C. § 103 as being unpatentable over Nakamura, alone or in combination with Jones and/or Hageman.

We will sustain the examiner's rejection of claims 15 through 17 under 35 U.S.C. § 103 as being unpatentable over Nakamura. We will also sustain the examiner's rejection of claim 21 under 35 U.S.C. § 103 as being unpatentable over Nakamura in view of Hageman. These claims only require that the slow speed rolls have a gap therebetween, not a "fixed gap" as recited in the claims previously considered. With regard to these claims, we agree with the examiner's determination (answer, p. 5) that it would have been obvious to one having ordinary skill in the art to adapt Nakamura's burster to (1) process business forms of a paper weight of 32 lbs. or less, or more specifically, 16-32 lbs., and (2) utilize a transport speed of about 600 fpm since discovering an optimum range or value involves only routine skill in the art.

Implicit in these rejections is the examiner’s view that the above noted modification of Nakamura would have resulted in a method which corresponds to the method recited in claims 15 through 17 and 21 in all respects.

The appellant has not presented any argument with respect to claims 15 through 17 and 21. The arguments presented in section

VI, Parts B and D of the brief (pp. 6-8 and 11) are all addressed to limitations not present in claims 15 through 17 and 21. Accordingly, the appellant has not specified any error in the rejection of claims 15 through 17 and 21.

For the above reasons, we will sustain the examiner's rejection of claims 15 through 17 under 35 U.S.C. § 103 as being unpatentable over Nakamura and the examiner's rejection of claim 21 under 35 U.S.C. § 103 as being unpatentable over Nakamura in view of Hageman.

We will not sustain the examiner's rejection of claim 20 under 35 U.S.C. § 103 as being unpatentable over Nakamura in view of Jones. We agree with the appellant's argument (brief, p. 11) that Jones does not teach or suggest driving the transport belts at a third speed slightly higher than the first speed of the slow speed rolls, but not as great as the second speed of the high speed rolls as recited in claim 20. While Jones does disclose a double conveyor belt unit 46-55 for conveying bags from nip rolls 40, 41 to folder rolls 56-58, Jones does not teach or suggest the step of driving transport belts at a third speed as recited in claim 20. Since the limitations of claim 20 is not taught or

suggested by the prior art applied by the examiner, we will not sustain the examiner's rejection of claim 20 under 35 U.S.C. § 103 as being unpatentable over Nakamura in view of Jones.

We will sustain the examiner's rejection of claims 1, 2, 9, 22, 24 and 26 under 35 U.S.C. § 103 as being unpatentable over Gergely in view of Hageman. With regard to these claims, we agree with the examiner's determination (answer, p. 8) that it would have been obvious to one having ordinary skill in the art to provide Gergely with a stationary breaker blade as suggested and taught by Hageman. Further, with regard to claims 2 and 22, we agree with the examiner's determination (answer, pp. 8-9) that it would have been obvious to one having ordinary skill in the art that the fixed gap of Gergely would have been between about 0.005-0.008 inches. Further, with regard to claim 24, we agree with the examiner's determination (answer, p. 9) that it would have been obvious to one having ordinary skill in the art to adapt Gergely's burster to process business forms of a paper weight of 32 lbs. or less since one of ordinary skill in the art would readily adapt the burster of Gergely to business forms of varying paper weights.

Implicit in this rejection is the examiner's view that the above noted modifications of Gergely would result in an apparatus which corresponds to the apparatus recited in claims 1, 2, 9 and 22 and a method which corresponds to the method recited in claims 24 and 26 in all respects.

The appellant's arguments (brief, pp. 12-15) are unpersuasive for the following reasons. First, Gergely discloses in Figure 1, a pair of spaced plates (unnumbered) for guiding the web 18 from tractors 26 to the rollers 10 and 12. These spaced plates are readable on the claimed guide elements/plates having a "fixed gap" therebetween. Second, we agree with the examiner that the appellant has not rebutted the examiner's determination (answer, p. 8) that the spaced plates of Gergely inherently prevent the formation of a form bubble. Third, we agree with the examiner (answer, pp. 12 and 14) that the size of the gap between the spaced plates of Gergely is a result effective variable since the size of the gap would have been set according to the actual thickness of the web being conveyed. Fourth, we agree with the examiner that an artisan would have interpreted the zigzagged line above roller 34 in Figures 6 and 7 of Gergely as being a representation of a spring to bias roller 34 towards roller 36.

In any event, we agree with the examiner (answer, p. 14) that Hageman would have suggested the use of spring biased high speed rollers.[4]

For the above reasons, we will sustain the examiner's rejection of claims 1, 2, 9, 22, 24 and 26 under 35 U.S.C. § 103 as being unpatentable over Gergely in view of Hageman.

We will not sustain the examiner's rejection of claims 23 and 25 under 35 U.S.C. § 103 as being unpatentable over Gergely in view of Hageman. We agree with the appellant's argument (brief, p. 15) that the recited guide plates are not taught or suggested by the applied prior art. In that regard, we find that there is no suggestion, absent the appellant's specification, to make the spaced plates of Gergely adjustable as recited in claims 23 and 25. Since the "adjustable" limitation is not taught or suggested by the prior art applied by the examiner, we will not sustain the examiner's rejection of claims 23 and 25 under 35 U.S.C. § 103 as being unpatentable over Gergely in view of Hageman.

---

[4] See Figure 7 where springs 53 urge upper high speed roll 50 into engagement with lower high speed roll 48.

Under the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection:

Claims 3 and 4 are rejected under 35 U.S.C. § 103 as being unpatentable over Gergely in view of Hageman for the reasons set forth above with respect to the § 103 rejections of claims 1 and 2 based on Gergely and Hageman and the additional reasons set forth below.

Claim 3 depends on claim 2 (addressed previously) and adds the limitation that the high speed rolls are spring biased together. As set forth above, we agree with the examiner that an artisan would have interpreted the zigzagged line above roller 34 in Figures 6 and 7 of Gergely as being a representation of a spring to bias roller 34 towards roller 36 and that, in any event, Hageman would have suggested the use of spring biased high speed rollers. Accordingly, it would have been further obvious to one having ordinary skill in the art to spring bias Gergely's rollers 34 and 36 together as suggested by Hageman's spring biased rolls 50 and 48.

Claim 4 depends on claim 1 (addressed previously) and adds the limitation that the fixed gap is about 0.007 inches. As set

forth above, we agree with the examiner that the size of the gap between the spaced plates of Gergely is a result effective variable. Accordingly, it would have been further obvious to one having ordinary skill in the art to space the spaced plates of Gergely apart by about 0.007 inches.

CONCLUSION

To summarize, the decision of the examiner to reject claim 1 under 35 U.S.C. § 102(b) as being anticipated by Nakamura is reversed; the decision of the examiner to reject claims 2 through 8, 10 through 14, 18 and 19 under 35 U.S.C. § 103 as being unpatentable over Nakamura, alone or in combination with Jones and/or Hageman is reversed; the decision of the examiner to reject claims 15 through 17 and 21 under 35 U.S.C. § 103 as being unpatentable over Nakamura, alone or in combination with Hageman is affirmed; the decision of the examiner to reject claim 20 under 35 U.S.C. § 103 as being unpatentable over Nakamura in view of Jones is reversed; the decision of the examiner to reject claims 1, 2, 9, 22, 24 and 26 under 35 U.S.C. § 103 as being unpatentable over Gergely in view of Hageman is affirmed; the decision of the examiner to reject claims 23 and 25 under 35 U.S.C. § 103 as being unpatentable over Gergely in view of

Hageman is reversed; and a new rejection of claims 3 and 4 under 35 U.S.C. § 103 as being unpatentable over Gergely in view of Hageman has been made pursuant to our authority under 37 CFR § 1.196(b).

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date hereof. 37 CFR § 1.197.

With respect to the new rejection under 37 CFR § 1.196(b), should the appellant elect the alternate option under that rule to prosecute further before the Primary Examiner by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision. In the event the appellant elects this alternate option, in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to us for final action on the affirmed rejection, including any timely request for reconsideration thereof.

No period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART; 37 CFR § 1.196(b)

WILLIAM E. LYDDANE Administrative Patent Judge	)
LAWRENCE J. STAAB Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
JEFFREY V. NASE Administrative Patent Judge	)

Appeal No. 96-3968
Application No. 08/117,669

NIXON AND VANDERHYE
1100 NORTH GLEBE ROAD
8TH FLOOR
ARLINGTON, VA 22201-4714

APPENDIX

1. A burster for business forms comprising:

a transport mechanism; a pair of driven high speed rolls; a plurality of guide elements for guiding forms to said high speed rolls; and a breaker blade between said guide elements and high speed rolls; and

said guide elements mounted so that said guide elements have a fixed gap, greater than zero, therebetween during processing of business forms having a particular weight, said fixed gap sufficient to prevent formation of a form bubble in business forms being burst by said burster.

15. A method of bursting continuous single part business forms having perforation lines formed periodically therein; and having a paper weight of about 32 lb. or less, utilizing a burster having gapped slow speed rolls upstream of high speed rolls, and a breaker blade between the slow and high speed rolls, comprising the steps of:

(a) feeding the forms with a paper weight of about 32 lbs. or less to the slow speed rolls at a speed not less than a first speed;

(b) driving the slow speed rolls at substantially the first speed;

© passing the forms through a gap between the slow speed rolls that is of sufficient spacing to prevent bubble formation in the forms;

(d) driving the high speed rolls at a second speed, significantly, greater than the first speed; and

(e) when a perforation moves past the slow speed rolls, effecting bursting at a perforation line.

APPEAL NO. 96-3968 - JUDGE NASE
APPLICATION NO. 08/117,669

APJ NASE

APJ LYDDANE

APJ STAAB

DECISION: **AFFIRMED-IN-PART; 1.196(b)**

Prepared By: Delores A. Lowe

DRAFT TYPED: 11 Sep 97

FINAL TYPED: